

Application Serial No. 09/460,913

under §103(a) as being unpatentable over Mozer, in view of U.S. Patent No. 6,044,347 to Abella et al. (hereinafter "Abella").

In response, Applicants traverse the §102(e) and §103(a) rejections raised in the present Office Action for at least the reasons set forth below. Applicants respectfully request reconsideration of the present application in view of the following remarks.

With regard to the rejection of claims 6, 7, 13, 14 and 19 under §102(e) as being anticipated by Mozer, without characterizing the Mozer patent publication, Applicants assert that Mozer should not be considered prior art in the present application. Mozer was filed on January 16, 2002 as a continuation of application serial number 09/328,656 filed on June 9, 1999, now abandoned. Applicants have submitted an affidavit under 37 C.F.R. §1.131 in connection with their prior response dated September 5, 2002. The affidavit, along with its accompanying exhibits (Exhibits 1 and 2), evidence the conception of an invention falling within one or more of the claims of the present invention at least prior to January 29, 1999, and thus prior to the filing date of the continuation application upon which Mozer is based. Consequently, Applicants submit that Mozer should not be considered prior art in the present application.

The Examiner contends that the effective filing date of the Mozer reference is December 6, 1996 (present Office Action; page 2, paragraph 5), based on a chain of several related applications dating back to provisional application serial number 60/032,788 filed on December 6, 1996. However, Applicants respectfully disagree with this contention and submit that the existence of a continuation-in-part application (serial number 09/328,656) in the chain of related applications corresponding to the Mozer patent publication, may prevent Mozer from claiming the benefit of the earlier filing date for purposes of being used as §102(e) prior art against the present application. Mozer is not entitled to the filing date of the grandparent application since the parent and child applications necessarily contain new matter compared to the grandparent application. See *Ex parte Gilderdale*, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal No. 89-0352).

As set forth in the Manual of Patent Examining Procedure (MPEP) §2136.03, when the cited §102(e) reference is a continuation-in-part of the parent, the filing date of the parent can only be used

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as the §102(e) date if it supports the claims of the issued child. Specifically, MPEP §2136.03, section IV states:

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a patent application, the patent application must (A) have a right of priority to the earlier date under 35 U.S.C. 120 and (B) support the invention claimed as required by 35 U.S.C. 112, first paragraph. "For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art'" under 35 U.S.C. 102(e). In re Wertheim, 646 F.2d 527, 537, 209 USPQ 554, 564 (CCPA 1981) (emphasis in original)

Applicants assert that the Examiner has failed to provide evidence that the parent application serial number 08/822,852 filed on March 24, 1997 supports the claims of the Mozer patent publication, and thus fails to show that Mozer is entitled to claim the benefit of the earlier filing date for purposes of being used as §102(e) prior art against the claimed invention. Moreover, the affidavit filed with Applicants' prior response evidences a date of conception for the claimed invention at least prior to the filing date of the continuation-in-part application serial number 09/328,656 of which the Mozer patent publication is a continuation. Thus, Applicants submit that Mozer should not be considered prior art in the present application.

For at least the above reasons, Applicants respectfully submit that claims 6, 7, 13, 14 and 19 are patentable. Accordingly, favorable reconsideration and allowance of these claims are respectfully solicited.

With regard to the rejection of claims 1-5, 9-12 and 18 under §103(a) as being unpatentable over Mozer, in view of Abella, Applicants assert that, for at least the reasons set forth above, Mozer should be removed as prior art in the present application. Accordingly, favorable reconsideration and allowance of claims 1-5, 9-12 and 18 are respectfully requested.

With regard to the rejection of claims 8 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over Mozer in view of the Examiner's assertion of "well-known prior art," Applicants submit that, as previously stated, Mozer should not be considered prior art in the present application. Furthermore, Applicants traverse the Examiner's taking of official notice and respectfully request that the Examiner cite a specific reference(s) in support of his position, as set forth in MPEP

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§2144.03. Accordingly, favorable reconsideration and allowance of claims 8 and 15-17 are respectfully solicited.

In view of the foregoing, Applicants believe that pending claims 1-19 are in condition for allowance and respectfully request withdrawal of the §102 and §103 rejections.

Respectfully submitted,

A handwritten signature in black ink, reading "Wayne L. Ellenbogen", with a long horizontal flourish extending to the right.

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